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E. Hillis
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PATENT

Docket No. 6050/54207 (LBL-IB-1506)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: XIAO-DONG XIANG; CHEN GAO; FRED DUEWER; HAI TAO YANG
Serial No.: 09/608,311
Filed: JUNE 30, 2000
For: ANALYTICAL SCANNING EVANESCENT MICROWAVE MICROSCOPE AND
CONTROL STAGE
Group:
Examiner:

**ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231**

INFORMATION DISCLOSURE STATEMENT

List of Sections Forming Part of This Information Disclosure Statement

The following sections are being submitted for this Information Disclosure Statement:

1. ☒ Preliminary Statements
2. ☒ FORM PTO-1449 (Modified)
3. ☐ Statement As To Information Material To Examination Not Found In Patents Or Publications
4. ☒ Identification Of Prior Application In Which Listed Information Was Already Cited And For Which No Copies Are Submitted Or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☒ Concise Explanation of Non-English Language Listed Information Items
8. ☐ Translation(s) of Non-English Language Documents
9. ☒ Identification of Person(s) Making This Information Disclosure Statement

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Section 1. Preliminary Statements

Applicants submit herewith patents, publications or other information of which they are aware, which they believe may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR 1.56.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 CFR 1.56(g)), an admission that the information cited is, or is considered to be, material to patentability or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

Section 2. PTO Form 1449 (modified)

FORM 1449 IS BEING SUBMITTED HEREWITH IN 3 PAGE(S).

Section 3. Statement As To Information Material To Examination Not Found In Patents Or Publications (Information not listed in PTO-1449)

Section 4. Identification of Prior Application in Which Listed Information Was Already Cited and For Which No Copies Are Submitted Or Need Be Submitted

Note: "A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120." 37 CFR 1.98(d).

WARNING: While a copy of a non-English language item of information need not be submitted if its was previously submitted to or cited by the Office in a prior application, provided it is properly identified in this statement and this application relies on that earlier filing date under 35 U.S.C. 120, nevertheless, the requirement in § 1.98(a)(3) for a concise explanation of non-English language information **would not** be satisfied by a statement that a reference was cited in the prosecution of a parent application. The concise explanation must explain the relevance as presently understood by the person designated in § 1.56(c) most knowledgeable about the content of the information. Notice of January 9, 1992, 1135 O.G. 13-25, at 20.

THIS APPLICATION RELIES, UNDER 35 U.S.C. § 120, ON THE EARLIER FILING DATE OF PRIOR APPLICATION 08/717,321 FILED ON SEPTEMBER 20, 1996, NOW U.S. PATENT NO. 5,821,410 AND APPLICATION 09/158,037 FILED ON SEPTEMBER 22, 1998, NOW U.S. PATENT NO. 6,173,604. SOME OF THE REFERENCES SHOWN IN THE PTO FORM 1449 WERE SUBMITTED TO AND/OR CITED BY THE OFFICE IN THESE PRIOR APPLICATIONS AND, THEREFORE, ARE NOT REQUIRED TO BE PROVIDED IN THIS APPLICATION.

Section 5. Cumulative Patents or Publications

NOTE: "When the disclosure of two or more patents or publications listed in an information disclosure statement are substantially cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative." 37 CFR 1.98(c).

STATEMENT

_____ is cumulative of the following patents or publications listed on Form PTO-1449
(modified):

In accordance with 37 CFR 1.98(c) a copy of only _____ is being submitted with this
information disclosure statement.

Section 6. Copies of Listed Information Items Accompanying This Statement

NOTE: 37 CFR 1.98(a)(2) requires that any information disclosure statement filed under § 1.97 shall include: "A legible copy of: (i) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included ..."

NOTE: The wording in § 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.

Legible copies of all items listed accompany this information disclosure statement.

☒ **Exception(s) to above**

☒ **Items in prior application from which an earlier filing date is claimed for this application as identified in Section 4.**

☐ Cumulative patents or publications identified in Section 5.

It is respectfully stipulated, however, that none of these references teach or render obvious, singly or when considered in combination, applicant's claimed invention. This citation does not constitute an admission that the references are relevant or material to the claims nor that a search has been made; the references are cited only as constituting the closest art of which the applicant is aware.

Section 7. Concise Explanation of Non-English Language Listed Information Items

- NOTE: "A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the information of each patent, publication, or other information listed that is not in the English language **shall** be included in any information disclosure statement filed under § 1.97. "The concise explanation may be either separate from the specification or incorporated therein." 37 CFR 1.98(a)(3).
- NOTE: "[T]he explanation required is limited to the relevance as understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office." Notice of January 9, 1992, 1136 O.G. 13-25, at 14.
- NOTE: "Where the information listed is not in the English language, but was cited in a search report by a foreign patent office, the requirement for a concise explanation of relevance is satisfied by submitting an English language version of the search report." Notice of January 9, 1992, 1136 O.G. 13-25, at 14.
- NOTE: "The concise explanation requirement for non-English language information may be met by submission of an English language version of the search report indicating the degree of relevance found by the foreign office." Notice of January 9, 1992, 1136 O.G. 13-25, at 20.
- WARNING: "The requirement in §1.98(a)(3) for a concise explanation of non-English information **would not** be satisfied by a statement that a reference was cited in the prosecution of a parent application." Notice of January 9, 1992, 1136 O.G. 13-25, at 20 (emphasis added).

TAIWAN (R.O.C.) PATENT NO. 117,656 (Claiming priority to USSN 09/158,037, now U.S. Patent No. 6,173,604 and USSN 60/059,471: This patent is entitled "SCANNING EVANESCENT ELECTRO-MAGNETIC MICROSCOPE," A novel scanning microscope is described that uses near-field vanescent electromagnetic waves to probe sample properties. The novel microscope is capable of high resolution imaging and quantitative measurements of the electrical properties of the sample. The inventive scanning evanescent wave electromagnetic microscope (SEMM) can map dielectric constant, tangent loss, conductivity, complex electrical impedance, and other electrical parameters of materials. The quantitative map corresponds to the imaged detail. The novel microscope can be used to measure electrical properties of both dielectric and electrically conducting materials.

Section 8. Translation(s) of Non-English Language Documents

NOTE: "If a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement." 37 CFR 1.98(c).

NOTE: "The Office does not intend to require translations unless they have been reduced to writing and are actually translations of what is contained in non-English language information. Applicants should note, however, that most examiners do not have the ability to understand information which is not English and the that Office will not routinely translate information submitted in a non-English language. The examiner will consider the information insofar as it is understood on its face, e.g., drawings, chemical formulas, English-language abstracts, but will not have the information translated unless it appears to be necessary to do so. Applicants are required to aid the examiner by complying with the requirements of a concise explanation in § 1.98(a)(3) for information submitted in a non-English language." Notice of January 9, 1992, 1135 O.G. 13-25, at 21.

☒ No English language translations of the foreign language patents, publications or information or parts thereof are readily available, except for those listed above.

☐ The following foreign language documents submitted are believed to be the equivalent or substantial equivalent of the English language documents identified below, which are also submitted herewith.

☐ Submitted herewith is an English language translation of the following foreign patents, publications or information or of those portions of those patents, publications or information considered to be material:

Section 9. Identification of Person(s) Making This INFORMATION DISCLOSURE STATEMENT

The person making this statement is the attorney who signs below on the basis of:

_____ the information supplied by the inventor(s)

X the information in the attorney's file

Dated:

2/26/01

Reg. No.:

33,201

Tel. No.:

(916) 498-1010



SIGNATURE OF ATTORNEY

John P. O'Banion
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231 on:

2/26/01


John P. O'Banion

2/26/01
Date of Signature

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)Applicant(s): **XIAO-DONG XIANG; CHEN GAO**

Docket No.

6050/54207(LBL-IB-1506)

Serial No.

09/608,311

Filing Date

JUNE 30, 2000

Examiner

Group Art Unit

Invention: **ANALYTICAL SCANNING EVANESCENT MICROWAVE MICROSCOPE AND CONTROL SCOPE**I hereby certify that this **INFORMATION DISCLOSURE CITATION (3 pages)**
(Identify type of correspondence)

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The

Assistant Commissioner for Patents, Washington, D.C. 20231 on

FEBRUARY 26, 2001

(Date)

JERRY V. KING

(Typed or Printed Name of Person Mailing Correspondence)


(Signature of Person Mailing Correspondence)

Note: Each paper must have its own certificate of mailing.

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CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)Applicant(s): **XIAO-DONG XIANG; CHEN GAO**

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Invention: **ANALYTICAL SCANNING EVANESCENT MICROWAVE MICROSCOPE AND CONTROL SCOPE**I hereby certify that this **CITATIONS (13)***(Identify type of correspondence)*

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The

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FEBRUARY 26, 2001*(Date)***JERRY V. KING***(Typed or Printed Name of Person Mailing Correspondence)*
*(Signature of Person Mailing Correspondence)***Note: Each paper must have its own certificate of mailing.**